

REMARKS

The non-final Office Action mailed August 19, 2008 has been received and carefully noted. Claims 49-92 are currently pending in the subject application and are presently under consideration.

Claims 49, 59, 71, and 83 have been amended herein. Support may be found in at least paragraphs 0064 and 0074 of the Specification. A listing of claims can be found on pages 2-14 of this Response.

Favorable reconsideration of the pending claims is respectfully requested in view of the amendments and the following comments.

I. Examiner Interview Summary

The Applicants thank the Examiner for courtesies extended during the telephonic interview with Jonathan S. Miller (Reg. No. 48,534) and Olivia J. Tsai (Reg. No. 58,350) on January 13, 2009. The Examiner provided suggestions of amendments to overcome the prior art of record. In a follow up telephone call on January 16, 2009, the Examiner confirmed that the amendments included herewith would overcome the current rejections. These amendments are supported by at least paragraphs 0064 and 0074 of the Specification. The Applicants note that the amendments suggested by the Examiner are included in this Response to advance the case to allowance, but the Applicants have not conceded that the sections of the prior art cited by the Examiner teach the aspects of the claims presented in the interview. The Applicants reserve the right to address and defend any of these issues at a later time, if necessary.

II. Claim Objections

Claims 52, 62, 74, and 86 have been objected to for introducing new matter. These claims recite:

wherein the *first transport protocol* is selected from the group comprising HyperText Transfer Protocol (HTTP), Simple Object Access Protocol (SOAP), SOAP over HTTP, SOAP over File Transfer Protocol (FTP), SOAP over Simple Mail Transfer Protocol (SMTP), and HTTP over Secure Socket Layer (HTTPS); and

wherein the *second transport protocol* is selected from the group comprising HTTP, SOAP, SOAP over HTTP, SOAP over FTP, SOAP over SMTP, and HTTPS, wherein the

second transport protocol selected is different from the first transport protocol selected.

(emphasis added). The Examiner contends that while the second transport protocol may be selected from the recited group, the first transport protocol is limited to SOAP according to Figure 6 and paragraphs 0020 and 0021 of the Specification (See Office Action mailed August 19, 2008, pg. 3). However, the cited portions of the Specification that specify a SOAP format simply set forth one example embodiment. The Specification clearly states that “[i]n alternative embodiments, protocols 660 implement a different message format” (See Specification, paragraph 0036) and therefore may be any of the types listed in claims 52, 62, 74, and 86. This support was noted in the telephonic interview and acknowledged by the Examiner. Accordingly, the Specification fully supports all the claim limitations and withdrawal of these objections is respectfully requested.

III. Rejection of Claims 71-92 Under 35 U.S.C. §101

Claims 71-92 are rejected under 35 U.S.C. §101. The Examiner cites *In re Comiskey* and states that these claims are non-statutory because they “could be implemented in software” and “do not require integrating a machine (e.g., a computer)” (See Office Action mailed August 19, 2008, pgs. 3 and 4).

Claims 71-82 recite “means for” language governed by 35 U.S.C. §112, sixth paragraph. As indicated in M.P.E.P. §2181, these claims must be examined in light of the Specification and “the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” It is noted that the Federal Circuit in the reversal opinion for *In re Comiskey* states that under the broadest reasonable interpretation, the means for claims of *In re Comiskey* recite the use of a machine (See *In re Comiskey*, 2006-1286, pg. 23 (January 13, 2009)). In the present case, the Specification characterizes the web service provider having the recited means as being supported by a hardware computing device (See Specification, paragraphs 0010, 0057, and 0126). Thus, these claims recite the use of a machine, e.g., “a desktop computer, laptop computer, tablet computer, handheld computer, personal digital assistant, telephone, household appliance, server, client, application server, and the like” (See Specification, paragraph 0010). In view of the above, the Applicants submit that claims 71-82 are statutory.

Independent claim 83 has been amended to recite a web service provider executed by an application server, which is a hardware computing device. The amendment is supported by at least paragraphs 0010, 0057, and 0126 of the Specification, *e.g.*, the Web service provider may be carried out “on suitably configured computing devices” such as “a desktop computer, laptop computer, tablet computer, handheld computer, personal digital assistant, telephone, household appliance, server, client, application server, and the like.” The Applicants believe that the amendment resolves this issue for claims 83-92.

Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

IV. Rejection of Claims 71-82 Under 35 U.S.C. §112, second paragraph

Claims 71-82 are rejected under 35 U.S.C. §112, second paragraph. M.P.E.P. §2181(II) states that “[t]he proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. *See Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).” The Examiner contends that the Specification does not disclose structure to support any of the means-plus-function limitations in the claims (*See* Office Action mailed August 19, 2008, pg. 5). However, the elements of at least Figures 4-7 depicted and described in the Specification present the structures that support the means-plus-function limitations in the claims. For example, a person having ordinary skill in the art would understand the “inside-out” architecture of Figure 4 to develop the Web service implementation before developing the Web service design time parts and Web service configuration parts corresponding to the Web service implementation (*See* Specification, paragraph 0016). The Specification further describes each of the recited parts, *e.g.*, element 422, “virtual interface,” *etc.* (*See* Specification, paragraphs 0016-0027). The Specification thus provides sufficient disclosure to support the means-plus-function elements of the claims. Accordingly, reconsideration and withdrawal of these rejections are respectfully requested.

V. Rejection of Claims 49-92 Under 35 U.S.C. §102(b)

Claims 49-92 stand rejected under 35 U.S.C. §102(b) as being anticipated by David A. Chappell and Tyler Jewell, *Java Web Services* (O'Reilly, March 2002) ("Chappell"). It is requested that these rejections be withdrawn for at least the following reason. Chappell does not describe each and every element of the claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). In particular, independent claim 49 recites:

.... the first Web service client including a client protocol implementation further including a user selected authentication protocol, the client protocol implementation to be set by a graphical user interface having a plurality of icons representing a plurality of authentication protocols, the user selected authentication protocol to be established by an icon in the plurality of icons selected by the user that corresponds to the user selected authentication protocol

Independent claims 59, 71, and 83 recite analogous aspects. The Examiner stated in the telephone call of January 16, 2009 that Chappell is silent regarding a graphical user interface having icons corresponding to a plurality of authentication protocols and the authentication protocol used for the Web service client is set by a user's selection of one of the icons. The Examiner noted that these limitations would overcome these rejections based on Chappell.

Claims 50-58, 60-70, 72-82, and 84-92 depend from independent claims 49, 59, 71, and 83, respectively, and thus incorporate the limitations thereof. For at least the aforementioned reasons regarding the amended independent claims, Chappell does not describe each and every element of these dependent claims. Accordingly, it is respectfully requested that these rejections be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: 2/19/09, 2009


Jonathan S. Miller

Reg. No. 48,534

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
Telephone (310) 207-3800

CERTIFICATE OF ELECTRONIC FILING
I hereby certify that this paper is being transmitted online via
EFS Web to the Patent and Trademark Office, Commissioner for
Patents, Post Office Box 1450, Alexandria, Virginia 22313-
1450, on 2-19 2009.

Melissa Stead 2-19-09
Melissa Stead